UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,363	03/17/2000	Mason Ng	40827.00039	4258

			EXAMINER
36614	7590	07/20/2004	LIN, KENNY S

MANATT PHELPS AND PHILLIPS
ROBERT D. BECKER
1001 PAGE MILL ROAD, BUILDING 2
PALO ALTO, CA 94304

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.		**Applicant(s)**		*11*
		09/528,363		NG ET AL.		
Office Action Summary		**Examiner**		**Art Unit**		
		Kenny Lin		2154		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2004.*

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-8 are presented for examination.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

4.   Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Narasimhan et al

(hereinafter Narasimhan), US Patent 6,073,165.

5.   Narasimhan was cited in the previous office action.

6.   As per claims 3-4, Narasimhan taught the claimed invention including a method,

comprising:

    a.   Establishing a communication channel with a client computer system (col.1, lines

       40-43, col.2, lines 50-65);

    b.   Receiving information corresponding to new email events from the client

       computer system (col.4, lines 6-11, col.6, lines 11-21, 40-56); and

    c.   Storing the information corresponding to the new email events in a database

       (col.4, lines 6-11, col.6, lines 11-21, 40-56).

7.   As per claims 5-6, Narasimhan taught the claimed invention including a method

comprising:

    a.   Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

    b.   Examining email data against the filter control data (col.5, lines 3-17);

    c.   Determining at least one transfer protocol for the email data based on the

       examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45); and

    d.   Forwarding the email data according to the at least one transfer protocol via a

       computer network to a database (col.6, lines 19-21, 40-56).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

    (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
    section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
    such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al

(hereinafter Chen), US Patent 6,510,455, in view of Paarsmarkt et al (hereinafter Paarsmarkt),

US Patent 6,118,856, and Narasimham et al (hereinafter Narasimhan), US 6,073,165.

10.   Chen, Paarsmarkt and Narasimhan were cited in the previous office action.

11.   As per claims 1-2, Chen taught the invention substantially as claimed including a method,

comprising:

      a.   examining start criteria (col.6, lines 12-22);

      b.   determining whether the start criteria have been met (col.6, lines 12-22, 25-31);

        and

      c.   obtaining new email events from an email database after the start criteria have

        been met (col.6, lines 25-52).

12.   Chen did not specifically teach the method to forward information corresponding to the

new email events via a computer network to a database. However, Paarsmarkt taught an email

system to forward information or portion of information corresponding to the new email events

via a computer network (col.2, lines 1-4, 15-17, 25-29, 48-52). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to combine the teachings of

Chen and Paarsmarkt because Paarsmarkt's teaching of forwarding information or portion of

information enables users to specify condition for forwarding received email to a remote device

in Chen's email system. Chen and Paarsmarkt did not specifically teach that to forward

information to a database. Narasimhan taught to store the information into database (col.4, lines

6-11, col.6, lines 11-21, 40-56). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to combine the teachings of Chen, Paarsmarkt and Narasimhan

because Narasimhan's teaching of storing the forwarded information in a database enables

subsequent recall of information from the database (col.6, lines 11-21).

13.   Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et

al (hereinafter Narasimhan), US Patent 6,073,165, in view of Moon et al (hereinafter Moon), US

Patent 6,138,146.

14.   Moon was cited in the previous office action.

15.   As per claims 7-8, Narasimhan taught the invention substantially as claimed including a

method, comprising:

    a. Obtaining filter control data (col.1, lines 46-49, col.2, lines 3-6);

    b. Examining email data against the filter control data (col.5, lines 3-17); and

    c. Determining based on the examination the email data that should not be

       forwarded (col.2, lines 3-6, col.5, lines 3-23);

    d. Generating receipt data identifying the email data that should be forwarded (col.1,

       lines 46-51, col.4, lines 6-11, col.6, lines 11-18); and

e. Forwarding the receipt data via a computer network to a database (col.4, lines 6-11, col.6, lines 11-21, 40-56).

16.   Narasimhan did not specifically teach the step of generating receipt data identifying the email data that <u>should not be</u> forwarded. Instead, Narasimhan taught to generate receipt data identifying the email data that <u>should be</u> forwarded (col.1, lines 46-51, col.4, lines 6-11, col.6, lines 11-18) and forward the receipt data via a computer network to a database (col.6, lines 19-21, 40-56). However, it would have been obvious that by identifying the email data that should be forwarded is equivalent to identify the email data that should not be forwarded. Moon taught to identify the email data that should not be forwarded and send the email data that should not be forwarded back to the server (col.2, lines 30-40, col.6, lines 16-20, col.7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narasimhan and Moon because Moon's teaching of identifying the email data that should not be forwarded enables Narasimhan's email system to be aware of which email messages to filter or block.

Conclusion

17.   Applicant's arguments filed on 4/26/2004 with respect to claims 1-8 have been fully considered but they are not persuasive.

18.   In the remark, applicant argued that: (1) As per claim 3-4, Narasimhan does not disclose receiving information corresponding to email <u>events</u>. (2) As per claims 5-6, Narasimhan did not

disclose determining transfer protocols for the email data based on the examination. (3) As per

claims 1-2, Paarsmarkt and Narasimhan does not disclosed forwarding email events. (4) As per

claims 7-8, Narasimhan did not teach to forward any sort of receipt data to a database.

19.   Examiner respectfully traverse the argument that:

As to points (1) and (3), Narasimhan taught to forward messages (col.6, lines 11-21, forwarding

known as a type of email event). Paarsmarkt also taught to forward email (col.2, lines 1-4, 15-

17, 25-29, 48-52).

As to point (2), Narasimhan taught to examine email data against the filter control data (col.5,

lines 3-17) and determining at least one transfer protocol for the email data based on the

examination (col.5, lines 42-49, col.6, lines 40-56, col.7, lines 39-45). Column 5, lines 36-41

that preceded the cited area stated, "After creating the filter message (taught in col.5, lines 3-17),

the source server encapsulates the filtered message and an associated address of the forwarding

service in another computer message, addressed to a selected destination server. The source

server may also include a receiver access code in the computer message, if needed." Column 5,

line 42-49, Column 6, lines 40-56 and Column 7, lines 39-45 goes on to disclose that different

protocols for data transfer may be used in accordance with the filtered results. Narasimhan

further taught to use different protocols for data transfer (col.3, lines 10-20, 39-44) and suggested

that many different communication protocols may be used (col.7, lines 42-45). In addition

Narasimhan taught that the data transferring method can be determined (col.4, lines 42-47).

As to point (4), This was addressed in the previous office action. Narasimhan taught to send

notice of receipt (col.3, lines 10-15, col.4, lines 6-11) to a database (col.6, lines 11-18).

20.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

21.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The

examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (703)305-8498. Additionally, the fax numbers for

Group 2100 are as follows:

Official Responses: (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703)305-6121.

ksl

July 12, 2004

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100